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PRE-APPEAL BRIEF REQUEST FOR REVIEW

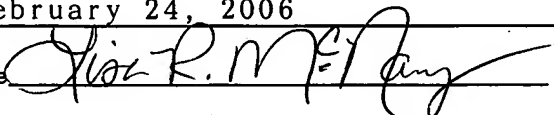
Docket Number (Optional)

4316-043718

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on February 24, 2006

Signature

Typed or printed name Lisa R. McNany

Application Number

10/799,820

Filed

March 12, 2004

First Named Inventor

Marc Joseph Thomas Lebert

Art Unit

3764

Examiner

Fenn C. Mathew

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

37,891

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Kirk M. Miles

Typed or printed name

412-471-8815

Telephone number

February 24, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APPELLANT'S PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application No. 10/799,820

Pre-Appeal Brief Dated Feb. 24, 2006

Reply to final Office Action of Oct. 24, 2005

Attorney Docket No. 4316-043718



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/799,820 Confirmation No. : 8364
Applicant : Marc Joseph Thomas Lebert
Filed : March 12, 2004
Title : **EXERCISE DEVICE AND SYSTEM**
Art Unit : 3764
Examiner : Fenn C. Mathew
Customer No. : 28289

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

For the reasons set forth herein, Applicant respectfully submits that the Final Action is based upon improper rejections of the claims and does not establish the asserted *prima facie* cases of anticipation or obviousness based on the cited references.

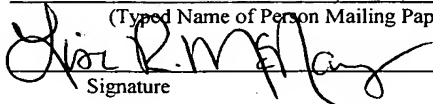
- I. Rejection of claims 1-3, 7, 10-19, 21, and 23-28 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,334,121 to McPhilomy

The Final Action fails to identify where the prior art McPhilomy patent teaches specific limitations which are present in the claims, resulting in a clear deficiency in the *prima facie* case in support of the rejection.

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Lisa R. McNany

(Typed Name of Person Mailing Paper)



Signature

02/24/2006

Date

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Independent claims 1 and 16 clearly recite "an elongate substantially upright weight-bearing portion for supporting the weight of a user during exercising", and further recite the transverse section and upstanding sections (with respect to claim 1), or the weight bearing portion (with respect to claim 16), as "being substantially rigid so as not to yield perceptibly to a user during exercise." The McPhilomy patent does not in any way teach or disclose such claim limitations, and in fact teaches away from these features.

As opposed to the rigid exercising device of the present invention which includes a weight-bearing portion for supporting the weight of a user, the McPhilomy patent teaches an interchangeable/adjustable hurdle made of PVC or other suitable material that "will not impede a runner's stride or trip the runner when struck." See col. 4, ll. 48-50. The structure of the hurdle of McPhilomy comprises a crossbar, two elbow joints, a pair of vertical members, two T-shaped joints, and at least one pair of horizontal members (feet) that fit together to provide a threadless friction-fit connection. The McPhilomy patent also teaches that a "forceful impact" with the crossbar will result in the hurdle falling apart without damage to the runner or parts of the hurdle. See col. 4, ll. 50-53.

In rejecting the claims, the Final Action contends at page 2 that "McPhilomy discloses an elongate substantially upright weight-bearing portion (78)". Element 78 of McPhilomy, however, is a crossbar of a hurdle, and in no way is intended as a "weight-bearing portion", let alone for supporting the weight of a user, as is required by the present claims. Moreover, the Final Action contends that McPhilomy also discloses "the transverse and upstanding sections being substantially rigid". The Final Action, however, fails to even suggest where McPhilomy teaches supporting sections which are sufficiently rigid so as not to yield perceptibly to a user during exercise. Instead, such limitations are merely ignored in the Examiner's rejection, demonstrating that the Examiner has failed to even consider such limitations with respect to the patentability of claims 1 and 16. As such, a *prima facie* case has not been established, in that specific limitations of the claims are not set forth as being present in McPhilomy.

Moreover, McPhilomy fails to teach or suggest such limitations, and in fact teaches away from such a rigid structure for supporting the weight of a user. In particular, McPhilomy is directed to hurdles which are lightweight and intended to be run over by a user. There is nothing in McPhilomy which teaches or remotely suggests providing the hurdles with the crossbar 78 as being a weight bearing portion for supporting the weight of a user. In fact, to do so would go entirely against the teachings of McPhilomy, which is to

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provide a structure to be run over by a user, and not in any way be contacted by the user. Moreover, as noted, McPhilomy specifically teaches that an advantage of his hurdle design is that forceful impact by a user with the crossbar 78 will result in the hurdle falling apart, i.e. yielding perceptibly. Thus, the intent of McPhilomy is to provide a structure that is the exact opposite of the claimed invention, i.e. a structure that falls apart upon impact as opposed to a structure which supports the weight of a user and will not yield perceptibly. In this manner, McPhilomy specifically and unequivocally teaches away from the claimed invention.

Additionally, independent claims 1 and 16 both require “the feet and weight-bearing portion being configured so that the mass of the device is generally balanced about said first plane.” As set forth in the specification at page 10, line 25 through page 11, line 13, such balance ensures that the device will not suddenly shift and will remain in a standing position when supporting the weight of a user. McPhilomy, however, fails to teach or suggest such a configuration with the feet and weight-bearing portion balanced in this manner. In fact, McPhilomy teaches a hurdle which easily collapses, and demonstrates in the figures, including FIG. 5, and in the accompanying description that one of the foot members is shorter than the other, thereby providing a hurdle that would easily topple when contacted by a user. Again, such disclosure teaches away from the present invention, which involves balancing the structure to ensure proper support of a user as opposed to providing a hurdle structure which is intended to easily topple during use.

Still further, the Final Action contends that “Claims 16-19, 21, 23-28 are substantially similar in scope to the claims cited above.” Applicant submits that such a rejection of independent claim 16 as being “substantially similar in scope to” other rejected claims is not a proper basis for rejection under 35 U.S.C. §102(b). Applicant asserts that independent claim 1 and independent claim 16 differ in their language and claim scope, and therefore should be considered independently of one another with respect to patentability.

In fact, claim 16 specifically recites “first and second exercise devices... configured to be independently positionable relative to one another... to permit the user to perform exercises involving the gripping with one hand of each gripping portion and the bearing of the user’s weight by both weight-bearing portions simultaneously”. McPhilomy fails to teach or suggest any structure which is configurable in this manner. The Final Action notes that “McPhilomy teaches multiple devices where distance and angle of placement are chosen by the user.” The Examiner, however, fails to demonstrate where McPhilomy teaches the claim limitations defining the devices as being each grippable with one hand and capable

of bearing the user's weight by both weight-bearing portions simultaneously. Again, such a use is entirely contrary to McPhilomy, which discloses hurdles which are not intended to support a user, whether used singly or in conjunction with each other, and instead are intended to collapse on impact with a user.

Based on these remarks, a *prima facie* case in support of the rejection of independent claims 1 and 16, and their respective dependent claims, as being anticipated by McPhilomy has not been met, and the rejection should be withdrawn as improper.

II. Rejection of claims 4-6 and 20 under 35 U.S.C. §103(a)
as being unpatentable over the McPhilomy patent alone

With respect to the rejection of dependent claims 4-6 and 20 as being obvious over McPhilomy, the final Office Action merely contends that specific diameters and choice of material are matters of design choice, absent criticality. Applicant submits, however, that a *prima facie* rejection based on obviousness requires that the prior art provide some suggestion or motivation to modify the reference in the suggested manner. See MPEP §2143.01. To the contrary, there is no motivation or suggestion in the McPhilomy patent to modify it in a manner as suggested, i.e. to include hollow metal tubing of specific diameters. In fact, to do so would go against the teachings of McPhilomy, whose intent is to provide a hurdle which can be easily carried, and which will not impede a runner's stride or trip the runner when struck, such as in a forceful impact. In fact, the ability to support the weight of the user during use is critical, as is apparent from the claim language requiring this limitation.

In addition, Applicant submits that the Examiner's contention that "the use of metal for hurdles is well known" is an improper basis for rejection. It appears that the Examiner is suggesting that it would be obvious to make a hurdle out of metal (with reference to U.S. Patent No. 3,685,824). Applicant, however, is not claiming a "hurdle", let alone a metal hurdle. Moreover, it is submitted that based on the teachings of McPhilomy, even making a metal hurdle would not in and of itself suggest an exercise device which would support the weight of the user, particularly since the hurdle would still be intended to collapse upon contact with a user.

In any event, there is nothing in McPhilomy which would teach or suggest modifying the disclosed hurdle in a manner to make it useful as an exercise device which

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supports the weight of a user. Accordingly, all elements required for a *prima facie* rejection under §103 have not been established, and this rejection should be withdrawn.

III. Rejection of claims 8-9 and 22 as being unpatentable over McPhilomy in view of U.S. Patent No. 4,258,915 to Sellge, Jr. et al.

The Final Action contends that McPhilomy teaches the claimed invention with the exception of rubber feet, and cites the Sellge patent as teaching rubber feet to prevent unwanted sliding. Sellge, however, fails to add anything to the deficiencies of the teachings of McPhilomy which would render the present invention obvious. Accordingly, the rejection of these dependent claims based on the combination of McPhilomy and Sellge should likewise be withdrawn.

IV. Conclusion

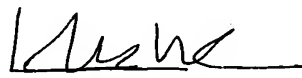
Based upon the above specified numerous clear errors and deficiencies, Applicant asserts that a *prima facie* rejection based on either anticipation or obviousness has not been established. It is therefore respectfully requested that the final rejections be withdrawn and reversed and the claims be allowed.

Any questions regarding this submission should be directed to Applicant's undersigned representative, who can be reached by telephone at 412-471-8815.

Respectfully submitted,

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